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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/220,617 12/24/98 JOHNSON

E 6029-7976

EXAMINER
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HM12/0330

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ART UNIT	PAPER NUMBER

1644  
DATE MAILED:

03/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/220,617**

Applicant(s)

**Johnson et al**

Examiner

**Robert C. Hayes**

Group Art Unit  
**1644**



☒ Responsive to communication(s) filed on Feb 7, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 10-15, 26, and 28-40 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 10-15, 26, and 28-40 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. The numbering of claims is not accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 13-44 have been renumbered 9-40. Therefore, claims 10-15, 26, & 28-40 are pending.

### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 10-15, 28-30 & 34-40, drawn to polynucleotides encoding persephin polypeptides, vectors, and associated host cells, classified in Class 435, subclass 530.
  - II. Claims 26 & 31-33, drawn to antisense oligonucleotides for use in gene therapy, classified in Class 514, subclass 44.

3. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relation of Inventions" in MPEP 806.05 for inventive groups that are directed to different products, restriction is deemed

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proper because these products appear to constitute patently distinct inventions for the following reason:

Groups I-II are directed to products that are physically and functionally distinct, which involve polynucleotides or oligonucleotides for use to inhibit translation and/or transcription. For example, the antisense oligonucleotide molecules of Group II are distinguished from the polynucleotides of Group I, in that the antisense oligonucleotides of Group II are used in gene therapy to form either RNase digestible secondary structures, or used to block the promoter regions of genes. In contrast, the polynucleotide molecules of Group I require sense strands to encode persephein proteins. Additionally, the short antisense oligonucleotides of Group II are generally smaller molecules than the nucleic acid molecules of Group I, and do not usually constitute a functional gene. Further, the vectors and host cells of Group I are not required for the oligonucleotide products of Group II, and vice versa. It is pointed out that there is a proper distinction between these groups, since each product is not required in order for the other to exist. Thereby, these groups are distinct and separable for the reasons stated.

Because these inventions are distinct for the reasons given above, they have acquired a separate status in the art as shown by their different classification, and the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider each of the separable groups with their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(I).


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.  
March 27, 2000



CHRISTINA Y. CHAN  
SUPERVISORY PATENT EXAMINER  
GROUP 1800-1640